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EXAMINER

NGUYEN, T

ART UNIT

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Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/454,689

Applicant(s)

KAPIL ET AL.

Examiner

Thu Ha T. Nguyen

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 December 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

**DETAILED ACTION**

1. Claims **1- 26** are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

**102(e)**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 37 1(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-7, 9-10, 13-15, 18-21 and 23-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Buckley et al.**, U.S. Patent No. **6,035,327**.

5. As to claim 1, **Buckley** teaches the invention as claimed, including a method of communicating in a network having a plurality of communities each including a server, the method comprising:

Receiving, from the server in a first community, a request indicating desired real-time, text-based messaging from a first terminal coupled to the first community server to a second terminal coupled to the server in a second community (Figs. 2, 3, col. 1 lines 65-col. 2 lines 19 and col. 7 lines 43-col. 8 lines 14).

Processing the request, by the server in the second community, to establish the real-time, text-based messaging session between the first and second terminals through the first and second community servers (Figs. 2, 3 and col. 8 lines 15-62).

6. As to claim 2, **Buckley** teaches the invention as claimed, further comprising determining if the second terminal has an established link with the second community server (Figs. 2, 3).

7. As to claim 3, **Buckley** teaches the invention as claimed, further comprising sending a notification to the second terminal of the desired messaging session if the second terminal has an established link with the second community server (Figs. 2, 3, col. 4 lines 8-17 and col. 7 lines 43-col. 8 lines 43).

8. As to claim 4, **Buckley** teaches the invention as claimed, including receiving an indication from the second terminal of whether the desired messaging session has been accepted (col. 12 lines 29-col. 13 lines 7 and col. 15 lines 22-67).

9. As to claim 5, **Buckley** teaches the invention as claimed, further comprising sending a message to a predetermined communications device other than the second terminal if the second terminal does not have an established connection with the second community server (col. 3 lines 5-18).

10. As to claim 6, **Buckley** teaches the invention as claimed, wherein sending the messages includes sending to a communications device including at least one of a telephone, a pager, and an electronic mail receiver (Fig. 3).

11. As to claim 7, **Buckley** teaches the invention as claimed, further comprising performing a reverse log on to the second terminal if the second terminal does not have an established link with the second community server (figs. 2, 3, col. 7 lines 24-col. 8 lines 62).

12. As to claim 9, **Buckley** teaches the invention as claimed, including a method of communicating in a system having a server, comprising:

Receiving, at the server, a request to contact a user (Fig. 2, col. 1 lines 65-col. 2 lines 19, col. 7 lines 43-col. 8 lines 14 and col. 16 lines 23-67).

Accessing predetermined information to determine a plurality of devices that may be employed for communicating with the user (Figs. 2, 3, col. 8 lines 15-62 and col. 16 lines 23-56).

Sending a message to at least one of the plurality of devices (Figs. 2, 3 and col. 7 lines 24-67).

13. As to claim 10, **Buckley** teaches the invention as claimed, further comprising storing the predetermined information listing a plurality of devices including a telephone and at least one other device (Fig. 1, col. 6 lines 8-62).

14. As to claim 13, **Buckley** teaches the invention as claimed, wherein the at least one other device is a non voice device (Fig. 1 and col. 6 lines 8-col. 7 lines 23).

15. As to claim 14, **Buckley** teaches the invention as claimed, including a system comprising:

A controller adapted to receive a request for establishing a messaging session with a user (Fig. 1, col. 6 lines 8-44).

A storage unit containing information identifying a plurality of devices that may be used to contact the user (Fig. 1 and col. 6 lines 8-col. 7 lines 23 and col. 10 lines 25-62).

An interface unit adapted to send a message to at least one of the devices (Fig. 1 and col. 6 lines 45-62).

16. As to claim 19, **Buckley** teaches the invention as claimed, including a server for use in a communications system having a plurality of communities coupled by

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a network, each community associated with a different service provider, the server being associated with a first one of the communities and comprising:

An interface unit adapted to receive a contact request over the network from an entity associated with another community, the entity not logged on to the server, the contact request indicating a request to establish a text-based messaging session with a destination terminal linked to the server (Fig. 1, 2, 3, col. 6 lines 45-62 and col. 7 lines 24-col. 8 lines 62).

A controller adapted to send a notification to the destination terminal of the contact request and to receive an indication from the destination terminal of acceptance of the contact request (Fig. 1, col. 6 lines 8-44).

17. As to claim 20, **Buckley** teaches the invention as claimed, including an article including one or more machine-readable storage media containing instructions for establishing a text-based messaging session between subscribers in a plurality of communities, each community associated with a different service provider, the instructions when executed causing a system in a first community associated with a first service provider to:

Receive a request from a subscriber in a second community associated with a second service provider, the request indicating a desired text-based messaging session with a subscriber in the first community (Fig. 7 and col. 16 lines 57-67);

Notify the subscriber in the first community of the request (Figs. 2, 3, col. 4 lines 8-17 and col. 7 lines 43-col. 8 lines 43).

Determine if the subscriber in the first community has accepted the request (col. 12 lines 29-col. 13 lines 7 and col. 15 lines 22-67).

Establish the text-based messaging session between the subscribers if the subscriber in the first community accepted (Figs. 2, 3 and col. 8 lines 15-62).

18. As to claim 21, **Buckley** teaches the invention as claimed, wherein the one or more storage media contain instructions that when executed cause the system to further send signaling to establish the text-based messaging session (col. 12 lines 29-col. 13 lines 7).

19. As to claim 23, **Buckley** teaches the invention as claimed, wherein the one or more storage media contain instructions that when executed cause the system to create a controller object adapted to control the text-based messaging session (Fig. 1 and col. 6 lines 8-col. 7 lines 23 and col. 10 lines 25-62).

20. As to claim 24, **Buckley** teaches the invention as claimed, wherein the one or more storage media contain instructions that when executed cause the system to:

Receive a request from a subscriber in a third community associated with a third service provider for a text-based messaging session (Fig. 2 element 66 and col. 7 lines 24-col. 8 lines 14).



Establish the text-based messaging session among the subscribers in the first, second, and third communities (Fig. 2, 3, col. 7 lines 24-42 and col. 8 lines 15-62).

21. As to claim 25, **Buckley** teaches the invention as claimed, including a data signal embodied in a carrier wave comprising one or more code segments containing instructions for communicating in a network having a server, the instructions when executed causing the server to:

Receive a request to contact a user (Fig. 2, col. 1 lines 65-col. 2 lines 19, col. 7 lines 43-col. 8 lines 14 and col. 16 lines 23-67).

Access predetermined information to determine a plurality of devices that may be employed for communicating with the user (Figs. 2, 3, col. 8 lines 15-62 and col. 16 lines 23-56).

Send a message to at least one of the plurality of devices (Figs. 2, 3 and col. 7 lines 24-67).

22. As to claim 26, **Buckley** teaches the invention as claimed, including a communications system, comprising:

A plurality of service providers each providing a communications network (Fig. 2 plurality of servers read as service providers);

A plurality of terminals coupled to respective communications networks provided by service providers (Fig. 2, plurality of terminals 62).

A control unit adapted to receive a messaging request from a terminal coupled to a first communications network and to establish a real-time messaging session with a second terminal coupled to a second communications network (Fig. 1, col. 6 lines 8-44).

23. As to claims 15-18, they are system claims directed to method of communicating in a network of system claims 10-13; therefore, they are rejected under the same rationale.

#### **Claim Rejections - 35 USC § 103**

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 8, 11-12, 16-17 and 22 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Buckley et al.**, U.S. Patent No. **6,035,327**, in view of **DeSimone** U.S. Patent No. **6,175,619**.

26. As to claim 8, **Buckley** does not explicitly teach the step of establishing a chat session between the first and second terminal. However, **DeSimone** teaches the invention substantially as claimed, further comprising establishing a chat session between the first and second terminals (abstract and col. 2 lines 40-col. 3 lines 37). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Buckley and DeSimone** to include the step of establishing a chat session between the first and second terminals because it would have a sufficient communication system to carry on a real-time conversation with other users by computer.

27. As to claim 11, **Buckley** does not explicitly teach the step of sending a message to the telephone includes sending it to a public switched telephone network. However, **DeSimon** teaches the invention substantially as claimed, wherein sending a message to the telephone includes sending it to a public switched telephone network (Figs. 1, 2, col. 4 lines 5-col. 5 lines 63). ). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Buckley and DeSimone** to include the step of sending a message to the telephone includes sending it to a public switched telephone network because it would have a sufficient communication system to be able to connect and carry on a real-time conversation with other users by computer.

28. As to claim 12, **Buckley** does not explicitly teach the step of converting a message into voice data to send to the telephone. However, **DeSimone** teaches the invention substantially as claimed, further comprising converting a message into voice data to send to the telephone (Fig. 2 and col. 31-41). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Buckley and DeSimone** to have the same motivation as set forth in claim 11, supra.

29. As to claim 22, **Buckley** does not explicitly teach the text-based messaging session includes a chat session. However, **DeSimone** teaches the invention substantially as claimed, wherein the text-based messaging session includes a chat session (Abstract and col. 2 lines 40-col. 3 lines 37). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Buckley and DeSimone** to have the same motivation as set forth in claim 8, supra.

30. As to claims 16-17, they are system claims directed to method of communicating in a network of system claims 11-12; therefore, they are rejected under the same rationale.

### Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (703) 305-7447. The examiner can normally be reached Monday through Friday from 8:30 AM to 5:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SPE Ayaz R. Sheikh, can be reached at (703) 305-9648.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

The fax number for art unit 2155 is (703) 305-7201.

Thu Ha Nguyen

April 5, 2001

  
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